

Appl. No. 09/832,510  
Amtd. dated 10/27/2003  
Amendment under 37 CFR 1.116 Expedited Procedure

PATENT

### **REMARKS/ARGUMENTS**

#### **I. Status of the Claims**

Claims 7-18 and 35-45 are pending.

#### **II. The Present Amendment**

Claim 35 has been amended to clarify that the steps of the method are performed in the order listed. Entry of the amendment is appropriate at this time as it places the claim in condition for allowance or, alternatively, places the claim in better condition for appeal.

The amendment adds no new matter.

#### **III. The Final Action**

##### **A. Introduction**

Applicants note with appreciation the indication that claims 11, 12, 39 and 40 would be allowable if rewritten in independent form.

##### **B. Rejection of the Claims as Anticipated**

The Final Action maintains the rejection of claims 7-10, 13-18, 35-38, and 41-45 as anticipated by Baxter-Lowe, U.S. Patent No. 5,468,611. According to the Action: "The claimed invention merely recites steps a, b and c. The claimed invention does not require the steps to be done in the order recited. Therefore the claimed invention as broadly interpreted reads on the reference." Final Action, at page 2, bottom paragraph.

The rejection is based on an incorrect premise. As amended in the Amendment dated February 26, 2003, claim 7 recites that the claimed method "[comprises] the following steps, in the following order". (Emphasis added). The Amendment explained, on page 7, that the "phrase [had] been added reciting that the steps are performed in the order shown." Claim 7 and the claims dependent thereon therefore do require that the steps be done in the order recited.

As noted, the Final Action states: "The claimed invention does not require the steps to be done in the order recited." This is clearly incorrect in light of the amendment to the

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claim made in the February 2003 Amendment. Further, the rejection rests on a "broad interpretation" of the claims which is not permissible given the February 2003, Amendment. As the Examiner is aware, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987) and MPEP §2131. Baxter-Lowe does not teach a method comprising the steps of claim 7, in the order of the steps of claim 7. Baxter-Lowe therefore does not anticipate claim 7 as presented.

Applicants respectfully submit that, upon reconsidering claim 7 in light of the February 2003 amendment, the Examiner will recognize that claim 7 and the claims dependent thereon are not anticipated by the Baxter-Lowe patent.

Applicants have amended claim 35 herein to also contain the recitation that the steps of the method are performed in the order in which they are listed. As amended, claim 35 and the claims dependent likewise cannot be given the "broad interpretation" required to find the claims anticipated by Baxter-Lowe. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

With regard to claims 15-18, Applicants observe that page 8 of the February 2003 Amendment presented the following analysis:

"Similarly, Baxter-Lowe does not anticipate claims 15-18. As already noted, to be a proper reference for purposes of §102(b), the reference must contain every element of the claim. The Action alleges that Table 2 anticipates the claim because residues 634 allegedly sets forth a peptide reading on the invention. But the Action fails to show that Baxter-Lowe sets forth primer pairs capable of amplifying a subsequence of an MHC nucleic acid which subsequence encodes a polypeptide comprising a peptide of SEQ ID NO:2. Accordingly, the Action has failed to show a prima facie case of anticipation."

The Final Action contains a blanket rejection of claims 13-18 allegedly for the reasons presented in the previous Office Action. The Final Action fails, however, even to acknowledge the Applicants' response, let alone articulate any reason the Applicants' argument is incorrect. Applicants understand that proper examination practice requires the Examiner to reconsider a

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rejection in light of the arguments presented by the Applicant and, if the Examiner continues to maintain the rejection, to state with particularity in what respects the Applicants' position is incorrect. The Examiner is respectfully requested to clarify the ground of rejection, or to withdraw the rejection.

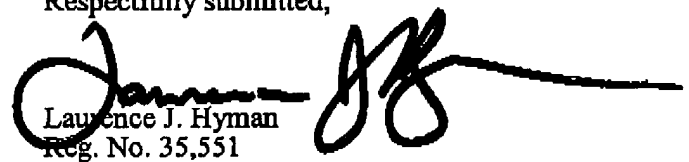
In conclusion, claims 7 and 35 provide that the steps of the claimed methods are to be performed in the order shown. Neither they, nor the claims depending from them, are anticipated by Baxter-Lowe. With respect to claims 15-18, Applicants observe that the Final Action does not explain why the response in the February 2003 was incorrect or deficient in showing the claims to be patentable over Baxter-Lowe. Applicants therefore respectfully request that the Examiner clarify or withdraw the rejection with respect to these claims.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,

  
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